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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KARL-LUTZ LAUTERJUNG

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Appeal 2009-015354  
Application 08/878,908  
Technology Center 3700

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Before STEVEN D.A. MCCARTHY, MICHAEL W. O'NEILL, and  
STEFAN STAICOVICI, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

### STATEMENT OF THE CASE

Karl-Lutz Lauterjung (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 65-73, 75-79, 81 and 82 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement; and claims 65 and 75-79 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner further rejected claim 32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 and 12 of copending U.S. Application No. 11/496,162. Claims 1-31, 33-64, 74 and 80 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6.

### THE INVENTION

The Appellant's invention relates to devices that are retained inside a body passage. Spec. 1, ll. 2-3 and fig. 1.

Claim 65 is representative of the claimed invention and read as follows:

65. A prosthesis comprising:

a tubular graft having a length, a pair of free ends opposed along the length of said graft, and a first diameter perpendicular to said length; and

a deformable ring having a second diameter, said second diameter parallel to said first diameter, the ring formed of a bundle of windings of a strand of resilient metal wire, said windings connected together to form the ring, the windings wrapped one over the other such that a particular winding has substantially continuous contact with one or more other windings for a complete turn of the particular winding, each winding being a closed loop of a portion of said metal wire, each loop having substantially said second diameter, each loop

lying substantially in a plane, the planes of said loops being parallel and substantially coplanar, the second diameter of said ring greater than the first diameter of the tubular graft, said ring secured to said graft adjacent one of said free ends, each of said loops constituting a length of a portion of said metal wire such that the loop wraps back upon itself, said loops defining a flattened helical coil wherein said loops that define the coil touch adjacent loops of the coil.

## SUMMARY OF DECISION

We REVERSE.

## OPINION

### *The obviousness-type double patenting rejection*

We do not reach the merits of the Examiner's provisional double patenting rejection because it would be premature to do so at this time, consistent with the holding of *Ex Parte Moncla*, 95 USPQ2d 1884, 1885 (BPAI 2010) (precedential).<sup>1</sup>

### *The § 112, first paragraph, rejection*

Although using different language, each of independent claims 65, 75, 81 and 82 requires the limitations that the loops of the claimed ring (annular element) be “parallel” and “substantially coplanar.” App. Br., Claims Appendix. The Examiner points to the Specification and Figures 1 and 10 to show that it is not clear that “one winding [of the wire] will necessarily form a parallel loop to another winding [of the wire].” Ans. 6. The Examiner

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<sup>1</sup> We note that instant U.S. Application No. 08/878,908 was filed before copending U.S. Application No. 11/496,162. As such, we direct the Examiner's attention to MPEP § 804(I)(B)(1).

further opines that “substantially coplanar” encompasses “coplanar” structures. Ans. 6.

To satisfy the written description requirement, the disclosure must convey with reasonable clarity to skilled artisans that Appellant was in possession of the claimed invention as of the filing date. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The inquiry into whether the description requirement is met is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, (CCPA 1976); *In re Ruschig*, 379 F.2d 990, 996 (CCPA 1967).

In this case, we find that the Appellant’s Specification discloses that strands 32 of the wire can be “*parallelly* connected” (emphasis added) and that the Appellant’s drawings (Figures 1 and 10) demonstrate windings of strands 32 of the wire, (i.e., loops) that are parallel. See Spec. 9, II. 1-2 and figs. 1 and 10. Further, although we agree with the Examiner that “substantially coplanar” encompasses “coplanar” structures, the use of the term “substantially,” often used in conjunction with another term to describe a particular characteristic of the claimed invention, is a broad term. *In re Nehrenberg*, 280 F.2d 161, 165 (CCPA 1960). Accordingly, the qualifying term “substantially” modifies the term “coplanar” to include loops that are approximately coplanar. In other words, the loops being “substantially coplanar” includes loops that occur in the same plane and loops that occur “approximately” in the same plane. In this case, upon review of Appellant’s Figure 10, we find that the loops 38, which are formed from the wound strands 32 of wire, are bundled so close to each other as to be “approximately” in the same plane. Hence, we find that Appellant’s Specification and drawings convey with reasonable clarity to a person of

ordinary skill in the art that the loops of the ring (annular element) are “parallel” and “substantially coplanar.”

Each of independent claims 65, 66, 70, 75, 81 and 82 further requires a “flattened” helical coil. App. Br., Claims Appendix. The Examiner takes the position that the ring 30 of Figure 10 is round, not flat, in cross-section. Ans. 7. The Appellant argues that the “illustrated coil [of Figures 1 and 10] is flattened at least in the direction of the length of the axis of symmetry where all the wraps of the coil are bunched together in a tight annular ring.” App. Br. 16.

At the outset, we note that both the Examiner and the Appellant acknowledge that the coils or strands 32 of the wire constitute a helical structure. See Ans. 7; Reply Br. 3. Appellant’s Specification describes ring 30 formed from strands 32 as being “compressed.” Spec. 9, ll. 1-6. Further, we find that Figures 1 and 10 of Appellant’s drawings show that the helical coil (strand 32) is flattened (collapsed/compressed) along the length of its axis. As such, we agree with the Appellant that the windings of the strands/coils 32 of the wire (i.e., loops) are “collapsed down on one another” to produce a flattened helical coil. Reply Br. 3. In conclusion, we find that the Appellant’s drawings (Figures 1 and 10) and Specification convey with reasonable clarity to one of ordinarily skilled in the art that the windings of the strands/coils 32 of the wire (i.e., loops) form a flattened helical coil.

Finally, each of independent claims 65, 66, 67, 70, 81 and 82 requires the loop(s) or the wire turn(s) back upon itself. App. Br., Claims Appendix. Further, independent claim 66 requires “a helical coil of a plurality of closed loops.” Br., Claims Appendix.

As noted above, both the Examiner and the Appellant acknowledge that the coils or strands 32 of the wire constitute a helical structure. See Ans.

7; Reply Br. 3. As such, because the Appellant describes forming helical ring 30 by wrapping a single length of wire around a mandrel (*see* Spec. 7, ll. 10-12), we find that the wire or loop of the wire will inherently turn back upon itself (i.e., there will be a change in direction along the length of the wire) during the formation of a helical coil. Hence, we agree with the Appellant that, “when the first loop [of the wire] is completed by a 360° revolution, a portion of the wire wraps back upon the end of the wire (i.e., wraps back upon itself).” App. Br. 17. We further find that a closed loop will essentially be formed when a wire completes a 360° revolution (around a mandrel) and moves slightly beyond its initial starting position during the formation of a helical coil. In conclusion, we find that a person of ordinarily skilled in the art would have readily appreciated that in the formation of a helical coil (1) a wire or a loop of the wire, wrapped around a mandrel, will inherently turn back upon itself (i.e., change direction); and (2) a closed loop will essentially be formed when a wire completes a 360° revolution (around a mandrel) and moves slightly beyond its initial starting position.

For the foregoing reasons, the rejection of independent claims 65, 66, 67, 70, 75, 81 and 82, and their respective dependent claims, under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, cannot be sustained.

*The § 112, second paragraph, rejection*

Independent claims 65 and 75 require “the planes of the loops being parallel and substantially coplanar” and loops being “substantially coplanar and parallel,” respectively. App. Br., Claims Appendix. The Examiner takes the position that the words “substantially coplanar” and “parallel” are mutually exclusive terms and that since “substantially coplanar”

encompasses “coplanar” structures, the terminology appears to “directly contradict” the modifier “parallel.” Ans. 8. In other words, according to the Examiner, “planes can be either parallel or coplanar, [but] not both since these terms are mutually exclusive.” Ans. 4-5.

It is well established that the test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). In this case, Appellant’s Specification discloses that strands 32 of the wire can be “*parallelly* connected” (emphasis added), and that ring 30 may be formed by wrapping the strands 32 of the wire around a mandrel. Spec. 7, ll. 10-12 and 9, ll. 1-2. As such, we find that wrapping (winding) strands 32 of the wire around a mandrel forms a bundle of loops of the wire, wherein the loops are wrapped in a parallel manner around the mandrel, such that the planes of the loops are parallel, which is also shown in Figures 1 and 10 of Appellant’s drawings. Further, although we agree with the Examiner that “substantially coplanar” encompasses “coplanar” structures, the use of the term “substantially,” often used in conjunction with another term to describe a particular characteristic of the claimed invention, is a broad term. Accordingly, the qualifying term “substantially” modifies the term “coplanar” to include the planes of loops and the loops themselves as being “approximately” coplanar. In other words, the planes of the loops and the loops being “substantially coplanar” includes the planes of the loops and the loops that occur “approximately” in the same plane. Upon review of Appellant’s drawings (Figures 1 and 10), we find that loops 38, which are formed from the wound strands 32 of wire, are bundled so close to each other as to be “approximately” in the same



plane. Hence, since the Specification and the drawings show the planes of the loops and the loops themselves as being parallel and substantially coplanar, we conclude that the claim language, when read in light of the Specification, is not indefinite. Accordingly, claims 65 and 75, and dependent claims 76-79, are not indefinite under 35 U.S.C. § 112, second paragraph. Hence, the rejection of claims 65 and 75-79 likewise cannot be sustained.

#### DECISION

The decision of the Examiner to reject claims 65-73, 75-79, 81 and 82 is reversed.

#### REVERSED

JRG